

Express Mail No. EV809055555US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	7507
Application No.:	10/538,950		
Int'l Appln. No.:	PCT/CH02/00707	I.A. Filing Date:	December 17, 2002
For:	INTERVERTEBRAL IMPLANT	Attorney Docket:	8932-1182-999 (new) (formerly LUS-16100)

New York, New York 10017
January 25, 2007

Mail Stop PCT
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Office of PCT Legal Administration

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REPLY TO DECISION ON PETITION UNDER 37 C.F.R. § 1.47(a)

Sir:

Applicants hereby reply to the Decision On Petition mailed November 29, 2006
in connection with this case.

To briefly recap, the USPTO erroneously mailed Notices Of Acceptance on
March 16 and 22, 2006.

On September 19, 2006, applicants filed an Inquiry Regarding Notice Of
Acceptance, a partially-executed Declaration And Power Of Attorney, a Petition For Filing By
Other Than All Inventors Under 37 C.F.R. § 1.47(a), and related papers.

On November 29, 2006, the USPTO mailed a Decision On Petition dismissing applicants' Petition and vacating the Notices Of Acceptance (copy of Decision enclosed).

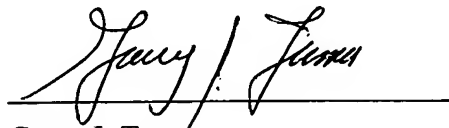
Applicants have since recently received a January 4, 2007 letter and an executed Declaration And Power Of Attorney from previously-uncooperative joint-inventor Max Aebi. Copies of the letter and executed Declaration are also enclosed (note that the Declaration was actually executed on January 3, 2007, not 2006).

As evidenced by the letter, Mr. Aebi did receive (and refused to execute) the Declaration and application papers previously sent by Ms. McPherson as indicated in her September 14, 2006 Statement Of Facts.

However, in view of applicants' receipt of the executed Declaration by Mr. Aebi, applicants do not renew their Petition For Filing By Other Than All Inventors and, instead, request issuance of a new Notice Of Acceptance Of Application.

Because this Reply is being filed within two months of the November 29, 2006 mail date of the Decision On Petition, no fee is believed due. However, if for any reason a fee is due in connection with this Reply, please charge that fee to Deposit Account No. 50-3013. A duplicate copy of this Reply is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Garry J. Tuma", is written over a horizontal line.

Garry J. Tuma
Registration No. 40,210
Attorney for Applicants

JONES DAY
Customer No. 51832
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New York, New York 10017
(212) 326-3939

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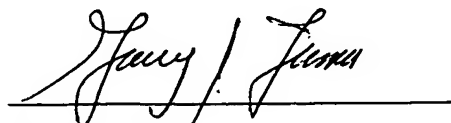
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Respectfully submitted,



Garry J. Tuma
Registration No. 40,210
Attorney for Applicants

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(212) 326-3939



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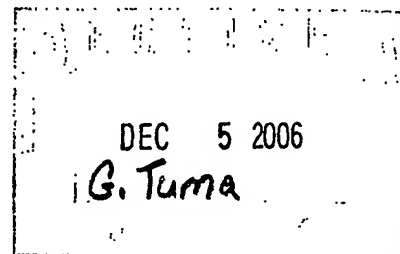
JONES DAY
222 EAST 41ST STREET
NEW YORK NY 10017-6702

In re Application of
AEBI, Max et al.
Application No.: 10/538,950
PCT No.: PCT/CH02/00707
Int. Filing Date: 17 December 2002
Priority Date: None
Attorney Docket No.: LUS-16100
For: INTERVERTEBRAL IMPLANT

DECISION ON

PETITION

UNDER 37 CFR 1.47(a)



This is a decision on applicants' petition under 37 CFR 1.47(a) filed 19 September 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

*Reconsideration of
Petition Due 11/29/07*

On 17 December 2002, applicants filed international application PCT/CH2002/000707. A copy of the international application was communicated from the International Bureau to the USPTO on 01 July 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 June 2005.

On 14 June 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 16 March 2006 and 22 March 2006, the Office mailed Notices of Acceptance (Form PCT/DO/EO/903) indicating that the application had complied with 35 U.S.C 371(c)(1), (c)(2) and (c)(4) on 14 June 2005.

On 14 September 2006, applicants filed this petition under 37 CFR 1.47(a), accompanied by a declaration of inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1) has been satisfied.

Item (2) has not been satisfied. Applicants allege that Mr. Aebe has refused to sign the declaration of inventorship, but have not established that the inventor was presented with a complete copy of the application papers including the specification, claims and drawings. Ordinarily, this is done by sending a complete copy of the papers to inventor's last known residence by return receipt mail.

Copies of documentary evidence supporting a presentation with a complete copy of the application papers should be provided. MPEP 409.03(d). The email delivery receipt confirms delivery of the email, not receipt. A refusal to sign in the absence of presentation with a complete copy of the application papers is not ordinarily sufficient.

Mr. Tuma states that Mr. Aebi was refusing to sign any papers related to the above-identified patent application as of 10 August 2005. As earlier indicated, refusal to sign in the absence of presentation with a complete copy of the application papers is not normally sufficient. Additionally, it is not clear that the author of the 10 August 2005 letter to Mr. Spaw has firsthand knowledge of the alleged refusal. Further, transfer of ownership rights is not required for Mr. Aebi to sign the declaration of inventorship.

Item (3) has not been satisfied. The last known address of a non-signing inventor is ordinarily the last known residence of the non-signing inventor. MPEP 409.03(e). The address provided for Mr. Aebi is a business address.

Item (4) has not been satisfied. The declaration includes the non-translated foreign language text "bitte leer lassen" handwritten on the declaration. Non-translated foreign language text is not acceptable. See 37 CFR 1.69.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

The Notices of Acceptance (Form PCT/DO/EO/903) mailed 16 March 2006 and 22 March 2006 are **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Erin P. Thomson
Attorney Advisor
PCT Legal Administration.

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

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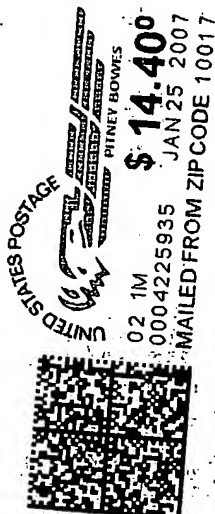


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DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below at 201 et seq. beneath my name.

I believe I am the original, first and sole inventor if only one name is listed at 201 below, or an original, first and joint inventor if plural names are listed at 201 et seq. below, of the subject matter which is claimed and for which a patent is sought on the invention entitled

INTERVERTEBRAL IMPLANT

and for which a patent application:

- ☒ was filed in the United States on June 14, 2005 as Application No. 10/538,959 and amended on even date, said application being a National Stage of
☒ PCT International Application No. PCT/CH02/000707, filed on December 17, 2002

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

EARLIEST FOREIGN APPLICATION(S), IF ANY, FILED PRIOR TO THE FILING DATE OF THE APPLICATION				
APPLICATION NUMBER	COUNTRY	DATE OF FILING (day, month, year)	PRIORITY CLAIMED	
			YES <input type="checkbox"/>	NO <input type="checkbox"/>
			YES <input type="checkbox"/>	NO <input type="checkbox"/>

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below.

PROVISIONAL APPLICATION NUMBER	FILING DATE

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information known to me which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

NON-PROVISIONAL APPLICATION NO.	FILING DATE	STATUS		
		PATENTED	PENDING	ABANDONED

POWER OF ATTORNEY: As a named inventor, I hereby appoint the Practitioners of Customer Number 51832, whose address is Jones Day, 222 East 41st Street, New York, New York 10017, my attorneys, to prosecute this application, and to transact all business in the Patent and Trademark Office connected therewith.

SEND CORRESPONDENCE TO:		JONES DAY 222 East 41st Street, New York, NY 10017 PTO Customer No. 51832		DIRECT TELEPHONE CALLS TO: JONES DAY DOCKETING 212-981-9828	
<p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.</p>					
2 0 1	FULL NAME OF INVENTOR	LAST NAME Aebi	FIRST NAME Max	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bern	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Gerechtigkeitsgasse 48	CITY Bern	STATE OR COUNTRY Switzerland	ZIP CODE CH-3011
	SIGNATURE OF INVENTOR 201			DATE Jan 3, 2006	
2 0 2	FULL NAME OF INVENTOR	LAST NAME Frigg	FIRST NAME Robert	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Mattenweg 8	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 202			DATE	
2 0 3	FULL NAME OF INVENTOR	LAST NAME Burkard	FIRST NAME Dominique	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Gretzenbach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Hasengasse 6	CITY Gretzenbach	STATE OR COUNTRY Switzerland	ZIP CODE CH-5014
	SIGNATURE OF INVENTOR 203			DATE	
2 0 4	FULL NAME OF INVENTOR	LAST NAME Lehmann	FIRST NAME Beat	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Grenchenstrasse 29a	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 204			DATE	

2 0 5	FULL NAME OF INVENTOR	LAST NAME Pavlov	FIRST NAME Paul	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Nijmegen	STATE OR FOREIGN COUNTRY Netherlands	COUNTRY OF CITIZENSHIP Netherlands	
	POST OFFICE ADDRESS	STREET Louiseweg 5	CITY Nijmegen	STATE OR COUNTRY Netherlands	ZIP CODE NL-6523
	SIGNATURE OF INVENTOR 205			DATE	
2 0 6	FULL NAME OF INVENTOR	LAST NAME Mathys Jr.	FIRST NAME Robert	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Chrützflacherstrasse 11	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 206			DATE	



^b
**UNIVERSITÄT
BERN**

MEM Forschungszentrum, Stauffacherstr. 78, CH-3014 Bern

Mr. Robert M. Rauker, Esq.
Vice President, Chief Patent Counsel
Synthes (USA)
1302 Wrights Lane East

West Chester, Pennsylvania 19380

U.S.A.

Medizinische Fakultät
MEM Forschungszentrum
Institut für Evaluative Forschung
in Orthopädischer Chirurgie

Bern, January 4th, 2007 Ae

**Re.: U.S. Patent Application No. 10/539,659 (filed June 14, 2005)
Corresponding to PCT/CH02/00704 (filed December 17, 2002)
Titled „Intervertebral Implant With Joint Parts Mounted On Roller Bodies“
(00070-05PUS1; 8932-1179-999; LU1981)**

**U.S. Patent Application No. 10/539,660 (filed June 14, 2005)
Corresponding to PCT/CH02/00705 (filed December 17, 2002)
Titled „Intervertebral Implant With Tilttable Joint Parts“
(00093-05PUS1; 8932-1180-999; LU1982)**

**U.S. Patent Application No. 10/538,542 (filed June 10, 2005)
Corresponding to PCT/CH02/00706 (filed December 17, 2002)
Titled „Intervertebral Implant Comprising Joint Parts That Are Mounted To
Form A Universal Joint“
(00083-05PUS1; 8932-1181-999; LU1983)**

**U.S. Patent Application No. 10/538,950 (filed June 14, 2005)
Corresponding to PCT/CH02/00707 (filed December 17, 2002)
Titled „Intervertebral Implant“
(00082-05PUS1; 8932-1182-999; LU1984)**

Dear Mr. Rauker,

I apologize for the delay of signing the declaration and power of attorney, but due to my situation with my Employer Universities I was waiting for advise from them what to do.

Please find now enclosed the duly signed Power of Attorney as requested. Please note that I agree that Jones Day will continue to prosecute the four patent applications listed in your letter of December 19, 2006, on behalf of the assignees.

Prof. Dr. med. et h.c. Max Aebi
MEM Stiftungsprofessor und Direktor
Stauffacherstrasse 78
CH-3014 Bern

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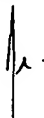
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I am at your disposition for any further questions or information.

Sincerely,



M. Aebi

cc:

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- Dr. H. Reutimann, Office of Technology Transfer, University of Bern,
Law office for patent application
- Jones Day, 222 East 41st Street, New York, NY 10017 / USA